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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/785,094
Filing Date: February 16, 2001
Appellant(s): GUDORF, GREGORY D.

Mr. Raymond Churchill (Reg. No. 44,617)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 17, 2008 appealing from the Office action mailed Oct. 19, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Van Zoest et al., U.S. Patent No. 6,609,105 Published Aug. 19, 2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 52-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure of the application does not describe "the plurality of audio files are exclusively accessible to different authentication information and the central location is configured to permit concurrent submission of the identification information of the user and audio file identification, without first transmitting a song selection list of the device".

- Claims 1-4, 6-10, 12-15 and 17-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Zoest et al., U.S. Patent No. 6,609,105 (referred to hereafter as Van).

Van teaches the invention explicitly as claimed including a system and method for downloading songs over the internet in response to performing user authentication (see abstract).

As to claim 1, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device (see col. 1 lines 33-50, user uploads songs to a website),

(b) associating the audio files with identification information (see col. 1 lines 33-50, the songs are personalized and protected by a user password),

(c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information (see col. 1 lines 33-50, songs are stored on the website),

(d) receiving at said central location said identification information from a second device (see col. 1 lines 33-50, user can access the songs from any web accessible terminal),

(e) transmitting said audio files to said second device upon receipt of said identification information (see col. 1 lines 33-50, songs are downloaded to client in response to client request).

As to claim 2, Van teaches the method of claim 1 wherein said server is a web server and said files and information are received and transmitted via the Internet (see col. 1 lines 33-50).

As to claim 3, Van teaches the method of claim 1 wherein at least one of said devices is a general purpose computer (see col. 1 lines 33-50).

As to claim 4, Van teaches the method of claim 3 wherein at least one of said devices is a personal computer (see col. 3 lines 55-63).

As to claim 6, Van teaches the method of claim 1 wherein at least one of said devices is a personal digital assistant (see col. 3 lines 53-65).

As to claim 7, Van teaches the method of claim 6 wherein said personal digital assistant receives said audio files via wireless communication (see col. 3 lines 53-65).

As to claim 8, Van teaches the method of claim 1 further comprising encoding said electronic files from a source of audio information (see col. 1 lines 55-col. 2 lines 7).

As to claim 9, Van teaches the method of claim 8 wherein said source is a compact disk (see col. 1 lines 55-col. 2 lines 7).

As to claim 10, Van teaches the method claim 1 wherein said electronic files are compatible with the MPEG format when received at said central location (see col. 1 lines 33-40).

As to claim 12, Van teaches the method of claim 1 further comprising receiving said identification from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 13, Van teaches the method of claim 1 wherein said step of receiving at said central location said identification information comprises said second device automatically sending said identification information to said central location (see col. 1 lines 25-col. 2 lines 7).

As to claim 14, Van teaches the method of claim 12 or 13 wherein said identification information is associated with said device. (see col. 1 lines 25-col. 2 lines 7).

As to claim 15, Van teaches the method of claim 14 wherein said first device and said second device are the same device (see col. 1 lines 25-col. 2 lines 7).

As to claim 16, Van teaches the method of claim 1 wherein said identification information is associated with a user (see col. 1 lines 25-col. 2 lines 7).

As to claim 17, Van teaches the method of claim 16 wherein said step of associating said audio files with identification information comprises a user sending information which identifies the user (see col. 1 lines 25-col. 2 lines 7).

As to claim 18, Van teaches the method of claim 1 wherein said identification information is sent from said first device when said first device is connected to said central location via a network (see col. 1 lines 25-col. 2 lines 7).

As to claim 19, Van teaches the method of claim 18 wherein said network is the Internet (see col. 1 lines 25-col. 2 lines 7).

As to claim 20, Van teaches the method of claim 19 wherein said identification information is sent automatically by said first and second devices to said central location (see col. 1 lines 25-col. 2 lines 7).

As to claim 21, Van teaches the method of claim 1 further comprising the step of receiving at said central location a request for at least one of said files and wherein said step of transmitting comprises transmitting said at least one of said files (see col. 1 lines 25-col. 2 lines 7).

As to claim 22, Van teaches the method of claim 21 further comprising the step of comparing the identification information associated with said requested file with the identification information received during said step of receiving said identification

information from said second device, and said step of transmitting is conditional upon the results of said comparison (see col. 1 lines 25-col. 2 lines 7).

As to claim 23, Van teaches the method of claim 22 further comprising the step of transmitting to said second device a list of the files associated with the identification information received from said second device (see col. 1 lines 25-col. 2 lines 7).

As to claims 24 and 25, Van teaches the method of claim 23 wherein the user is limited to a predetermined amount of space on the central location (see col. 1 lines 23-37).

As to claim 26, Van teaches the method of claim 1 wherein said second device is at a geographic location remote from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 27, Van teaches the method of claim 1 wherein said step of transmitting comprises downloading said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 28, Van teaches the method of claim 27 wherein said step of transmitting comprises streaming said file to said second device (see col. 1 lines 25-col. 2 lines 7).

As to claim 29, Van teaches the method of claim 27 wherein said step of transmitting comprises permitting said second device to permanently store said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 30, Van teaches the method of claim 1 further comprising:

(a) receiving at said central location electronic files representing audio signals from a third device, said third device having different identification information,

(b) storing the audio files from said third device on a portion of said storage media that is different from the portion uniquely associated with said identification information associated with said audio files from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 31, Van teaches a system for storing and transmitting audio information comprising:

a processor;

memory;

data stored in said memory, said data identifying a plurality of users or devices, said data further comprising a plurality of files associated with audio information, each said file being uniquely associated with the identity of a single user or device;

a set of instructions executable by said processor, said instructions conditioning the transmission of a song from the system to a user or device based on the identity of the user or device associated with said audio information (see col. 1 lines 25-col. 2 lines 7).

As to claim 32, Van teaches the system of claim 31 wherein the total size of files stored in said data for a particular user or device is limited (see col. 1 lines 25-col. 2 lines 7).

As to claim 33, Van teaches the system of claim 32 wherein a file associated with a first user is identical to a file associated with a second user and said data comprises two copies of said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 34, Van teaches the system of claim 31 wherein said system comprises a server (see col. 1 lines 25-col. 2 lines 7).

As to claim 35, Van teaches the system of claim 34 further comprising an audio player connected via a network to said server, said audio player being identified by at least some of the data identifying a plurality of users or devices (see col. 1 lines 25-col. 2 lines 7).

As to claim 36, Van teaches the system of claim 35 wherein said audio player comprises memory containing information identifying said player (see col. 1 lines 25-col. 2 lines 7).

As to claim 37, Van teaches the system of claim 36 wherein said audio player further comprises a speaker and a processor for playing said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 38, Van teaches the system of claim 36 wherein said audio player sends the identification information automatically to said server (see col. 1 lines 25-col. 2 lines 7).

As to claim 39, Van teaches the system of claim 36 wherein said remote device is a PDA (see col. 1 lines 25-col. 2 lines 7).

As to claim 41, Van teaches the system of claim 31 wherein said identification information comprises a portable audio player (see col. 1 lines 25-col. 2 lines 7).

As to claims 42 and 51, Van teaches a method of storing and transmitting songs comprising:

uniquely associating a portion of the storage space on a server with a user or device;

associating said portion with a first identifier;

receiving said first identifier;

receiving a song file representative of a song; and

storing said song file in the portion of said storage space associated with said first identifier;

receiving a second identifier and a request for said song file;

comparing said second identifier with the identifier associated said requested song file;

transmitting said song file in response to said request depending upon the outcome of said step of comparing (see col. 1 lines 25-col. 2 lines 7).

As to claim 43, Van teaches the method of claim 42 wherein if a first file is received along with a first identifier and a second file is received along with a second identifier and said first file and second file are identical copies of one another, then said

first file is stored on a portion of said storage space different from the portion where said second file is stored (see col. 1 lines 25-col. 2 lines 7).

As to claim 44, Van teaches the method of claim 43 further comprising the step of tracking the number of times a song file has been transmitted (see col. 1 lines 25-col. 2 lines 7).

As to claim 45, Van teaches the method of claim 42 wherein said step of storing said song file in the portion of said storage space associated with said first identifier occurs prior to said step of associating said portion with a first identifier (see col. 1 lines 25-col. 2 lines 7).

As to claim 46, Van teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from said user (see col. 1 lines 25-col. 2 lines 7).

As to claim 47, Van teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from a bank of song files (see col. 1 lines 25-col. 2 lines 7).

As to claim 48, Van teaches the method of claim 47 further comprising the step of said song bank preventing access to said song file stored at said song bank for an amount of time (see col. 1 lines 25-col. 2 lines 7).

As to claim 49, Van teaches the method of claim 48 wherein said amount of time is determined by the number of times a user is permitted to download the song (see fig. 3).

As to claim 40 and 50, Van teaches the identification information comprises a GUID (see col. 2 and 4 lines 49-56).

As to claim 52, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device (see col. 1 lines 33-50, user uploads songs to a website),

(b) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information (see col. 1 lines 33-50, songs are stored on the website),

(c) receiving at said central location said identification information from a second device (see col. 1 lines 33-50, user can access the songs from any web accessible terminal),

(d) transmitting said audio files to said second device upon receipt of said identification information (see col. 1 lines 33-50, songs are downloaded to client in response to client request);

wherein different stored sets of files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information,

wherein the central location is configured to permit concurrent submission of the authentication identification of the user and the file for transmitting at least one of the audio files to the device, without first transmitting a song selection list of the device (see col. 18 lines 55-col. 19 lines 50).

As to claims 53-55, Van teaches the method and system of claims 1, 31 and 42 respectively wherein the central location is configured to permit concurrent submission of the authentication identification of the user and the file by the second device (see col. 18 lines 55-col. 19 lines 50).

- Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van.

As to claim 5, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device, (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information, (d) receiving at said central location said identification information from a second device, (e) transmitting said audio files to said second device upon receipt of said identification information (see the rejection of claim 1) where the second device can be a portable computer, laptop, PDA etc.. where the files are downloaded using wireless communication.

Van does not explicitly teach the limitation "second device is installed in an automobile". Official Notice is taken that one of the ordinary skill in the art at the time of

the invention would modify Van to implement the second device in an automobile because doing so would allow the user to download and listen to songs from the internet and therefore overcome the need of using a physical storage device such as CD ROM or diskette and therefore having easier and more efficient method of saving audio files.

As to claim 11, Van does not explicitly teach the limitation electronic files are compatible with the ATRAC3 format when received at said central location". Van teaches the audio files can be saved in MPEG, .au, .snd, .aiff, etc. file formats. Official Notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Van by incorporating ATRAC3 format because doing so would allow the user to download audio files in different formats and using different software to play the audio file and therefore overcoming the limitation of a specific software to play the audio file.

(10) Response to Argument

As per appellants arguments filed on July 17, 2008, the appellant argues that the specification fully satisfies the written description requirement under 35 USC 112 with respect to subject matter in claims 52-55 (see Brief pages 10-13, argument A).

In reply to A, the applicant's specification does not show support for the limitation "the central location is configured to permit concurrent submission of the authentication information of the user and audio file information". The specification describes submission of user identification information and audio identification information which

do not necessarily have to be submitted "concurrently". In fact, the word "concurrent" does not appear anywhere in the disclosure of the application.

Appellant argues that applicant's documentary and Testimonial Evidence of a prior conception disqualifies Van Zoest reference (see Brief pages 14-18, argument B).

In reply to B, the evidence submitted on Oct. 24, 2005 is insufficient to establish a conception of the invention prior to the effective date of the Van reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Exhibit A shows a general idea of uploading songs to a server and accessing the songs from a different device. The supplemental declaration states on page 2 that "your music server" concept was to be used with some form of user authentication such as a user name and password that would associate the user to particular audio files or a personal account. The authentication with a user name and password concept that would associate a user to particular audio files based on the user "log in" information is not "clearly" shown in Exhibit A and therefore the submitted evidence does not show conception for the claim limitations (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information and (d) receiving at said central location said identification information from a second device.

In addition, Exhibit A does not show the concept of associating user authentication information with audio files and transmitting the audio files to the device based upon the receiving of the authentication information. Exhibit A, slide 5, simply shows uploading and downloading of audio files to a server. The uploading and downloading does not show any type of identification information received from the user and also does not show any association between user identification information and the uploaded audio files. The audio files of Exhibit A may simply be uploaded to a webpage which is accessible to any user on the internet without the use of any authentication information.

The evidence submitted on July 24, 2006 is insufficient to establish a conception of the invention prior to the effective date of the Van reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Applicant relies on a discussion between Mr. Gudorf and Mr. Beckwitt to show conception for the claim language. A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this

conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. Therefore applicant's statement is insufficient to show conception.

Appellant argues that Van Zoest does not disclose the central location is configured to permit concurrent submission of the user identification information and audio identification information for transmitting the at least one audio file to the device (see Brief pages 18-20, argument C).

In reply to C, Van Zoest teaches a system and method including sending user identification to a server and in response to the validation of the user identification information, sending the requested work "audio file" to the user (see col. 20 lines 31-40 and 59-col. 21 lines 3). The work "audio file" is sent to the user based on the user authentication and not based on a user selection from a list. Therefore Van Zoest teaches "permit concurrent submission of the user identification information and audio identification information for transmitting the at least one audio file to the device" as claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hussein Elchanti/

Oct. 9, 2008

Conferees:

/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457

/saleh najjar/

Supervisory Patent Examiner, Art Unit 2455